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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/451,666 11/30/99 ITO

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EXAMINER

FORMAN, B

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

07/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	09/451,666		ITO ET AL.	
	Examiner		Art Unit	
	BJ Forman		1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |  |  |
|--|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓                                   | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓               | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . ✓ | 20) <input type="checkbox"/> Other:  |

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**DETAILED ACTION**

1. Applicant's election without traverse of Group I, claims 1-3, filed 28 June 2000 in Paper No. 9 is acknowledged. Claims 4-15 are withdrawn from further consideration. Claims 1-3 are discussed below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are indefinite in the recitation of method steps because it is unclear whether the claims are drawn to a product or process. Clarification is required.

Claim 2 is indefinite in the recitation "the material of the plate" because "the material" lacks proper antecedent basis in Claim 1. It is suggested that the claim be amended to recite "wherein the plate is of a material selected from the group.....".

Claims 2 & 3 are indefinite in the recitation "selected from the group comprising" because "comprising" is open claim language and therefore it is unclear what members comprise the group. It is suggested that the claims be amended to claim the groups with proper Markush language i.e. replace "comprising" with "consisting of" (see MPEP 2173.05(h)).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Beattie (U.S. Patent No. 5,843,767, filed 10 April 1996). Claims 1-3 are drawn to a biochip comprising probes spotted on a plate at a plurality of positions wherein a binding agent is spotted at the positions where the probes are spotted. For purposes of examination, the claims are interpreted as product claims wherein method steps are not given patentable weight and the active step i.e. "spotted" is interpreted as being characterized by the appearance of spots.

Regarding Claim 1, Beattie teaches a biochip comprising probes spotted on a plate at a plurality of positions (Column 5, lines 28-44) wherein a binding agent is spotted at the plurality of positions where the probes are spotted (Column 6, lines 21-25).

Regarding Claim 2, Beattie teaches the biochip of Claim 1 wherein the plate is a silicone wafer (Column 13, lines 24-49).

Regarding Claim 3, Beattie teaches the biochip of Claim 1 wherein the binding agent is silylation-coating (Column 13, lines 55-64).

6. Claims 1-3 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Winkler et al. (U.S. Patent No. 6,040,193, filed 4 August 1998). Claims 1-3 are drawn to a biochip comprising probes spotted on a plate at a plurality of positions wherein a binding agent is spotted at the positions where the probes are spotted. For purposes of examination, the claims are interpreted as product claims wherein method steps are not given patentable weight and the active step i.e. "spotted" is interpreted as being characterized by the appearance of spots.

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Regarding Claim 1, Winkler et al. disclose a biochip comprising probes spotted on a plate at a plurality of positions (Column 2, lines 18-34) wherein a binding agent is spotted at the plurality of positions wherein the probes are spotted (Column 23, lines 9-12) and wherein the binding agent is "spotted" by deprotecting the plate at the plurality of positions (Column 24, lines 16-22).

Regarding Claim 2, Winkler et al. disclose the biochip of Claim 1 wherein the plate is glass (Column 23, lines 30-32).

Regarding Claim 3, Winkler et al. disclose the biochip of Claim 1 wherein the binding agent is silylation-coating (Column 23, lines 30-32).

7. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Takashi et al. (EP 0895 082 A2, published 2 March 1999). Claims 1-3 are drawn to a biochip comprising probes spotted on a plate at a plurality of positions wherein a binding agent is spotted at the positions where the probes are spotted. For purposes of examination, the claims are interpreted as product claims wherein method steps are not given patentable weight and the active step i.e. "spotted" is interpreted as being characterized by the appearance of spots.

Regarding Claim 1, Takashi et al. disclose a biochip comprising probes spotted on a plate at a plurality of positions (page 2, lines 52-56) wherein a binding agent is spotted at the plurality of positions wherein the probes are spotted (page 5, lines 34-36).

Regarding Claim 2, Takashi et al. disclose the biochip of Claim 1 wherein the plate is glass (page 6, lines 35-37).

Regarding Claim 3, Takashi et al. disclose the biochip of Claim 1 wherein the binding agent is silylation-coating (page 6, lines 35-37).

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**Conclusion**


8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
BJ Forman, Ph.D.  
July 6, 2000

  
S. Forman  
July 6, 2000